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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,311	07/19/2001	Heiner Max	Beiersdorf 733-KGB	9953

7590

07/25/2002

Norris McLaughlin & Marcus PA
220 East 42nd Street
30th Floor
New York, NY 10017

EXAMINER

BAHAR, MOJDEH

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/25/2002 *12*

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,311

Applicant(s)

MAX ET AL.

Examiner

Mojdeh Bahar

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,10-12 and 14-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,10-12 and 14-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's amendments and response to the first office action of February 12, 2002, submitted May 13, 2002 (Paper No. 11) is acknowledged.

Applicants amendment is persuasive to remove the rejection under 35 USC 102 in the previous office action.

Claims 8, 10-12, 14-23 are herein examined on the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8, 10-12, 14-16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanchez et al. (WO 95/19108).

Sanchez et al. (WO 95/19108) teaches a method for reducing shiny, moist, oily appearance of the skin employing a composition comprising of beta-cyclodextrin, see example 4, page 5 lines 14-20 in particular. Sanchez et al. also teaches a skin and hair cleaning composition

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comprising from about 1% to 30% cyclodextrins (alpha, beta and gamma) by weight, see claims 6-11 in particular. Sanchez et al. further teaches that its composition is employed in methods of removing lipids from the skin and hair and can be used in treating patients suffering from seborrhea or acne, see page 1, lines 4-5 and page 3, lines 1-2. Sanchez also teaches that the composition can be incorporated into gels, lotions, creams, suspensions, see in particular page 3 and Example 4 on page 5.

Sanchez does not particularly teach that at least 30% of the cyclodextrin component comprise gamma-cyclodextrin.

It would have been obvious to employ a composition in a method of treating diseases/conditions associated with the production of sebum in which at least 30% of the cyclodextrin component comprise gamma-cyclodextrin.

One of ordinary skill in the art would have been motivated to employ a composition in a method of treating diseases/conditions associated with the production of sebum in which at least 30% of the cyclodextrin component comprise gamma-cyclodextrin because optimization of amounts is within the skill of the artisan, absent evidence to the contrary. No such evidence is seen.

Claims 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanchez et al. (WO 95/19108) in view of Remington's Pharmaceutical Sciences.

Sanchez et al. (WO 95/19108) teaches a method for reducing shiny, moist, oily appearance of the skin employing a composition comprising of beta-cyclodextrin, see example 4, page 5 lines 14-20 in particular. Sanchez et al. also teaches a skin and hair cleaning composition comprising from about 1% to 30% cyclodextrins (alpha, beta and gamma) by weight, see claims

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6-11 in particular. Sanchez et al. further teaches that its composition is employed in methods of removing lipids from the skin and hair and can be used in treating patients suffering from seborrhea or acne, see page 1, lines 4-5 and page 3, lines 1-2. Sanchez also teaches that the composition can be incorporated into gels, lotions, creams, suspensions, see in particular page 3 and Example 4 on page 5.

Sanchez does not teach the employment of castor oil in its composition.

Remington teaches castor oil as a known emollient employed in the cosmetic art.

It would have been obvious to one of ordinary skill in the art to employ castor oil in the composition of Sanchez.

One of ordinary skill in the art would have been motivated to employ castor oil in a hair and skin composition because castor oil is a known emollient employed in cosmetic compositions.

Claims 17, 20, 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanchez et al. (WO 95/19108) in view of Flick.

Sanchez et al. (WO 95/19108) teaches a method for reducing shiny, moist, oily appearance of the skin employing a composition comprising of beta-cyclodextrin, see example 4, page 5 lines 14-20 in particular. Sanchez et al. also teaches a skin and hair cleaning composition comprising from about 1% to 30% cyclodextrins (alpha, beta and gamma) by weight, see claims 6-11 in particular. Sanchez et al. further teaches that its composition is employed in methods of removing lipids from the skin and hair and can be used in treating patients suffering from seborrhea or acne, see page 1, lines 4-5 and page 3, lines 1-2. Sanchez also teaches that the

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composition can be incorporated into gels, lotions, creams, suspensions, see in particular page 3 and Example 4 on page 5.

Sanchez does not teach the employment of an alcohol, triglycerides, capric or caprylic acid in the composition employed in its method.

Flick teaches the employment of caprylic acid, capric acid, triglyceride, octyldodecanol as components of its skin cream, see in particular page 92.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ caprylic acid, capric acid, triglyceride, octyldodecanol in the composition employed in the method of Sanchez.

One of ordinary skill in the art would have been motivated to employ caprylic acid, capric acid, triglyceride, octyldodecanol in the composition employed in the method of Sanchez because they are known cosmetic additives.

Response to Arguments

Applicant's arguments filed May 13, 2002 have been fully considered but they are not persuasive. Note that in his remarks as to the obviousness rejection applicant states the following : “ Examiner incorrectly cites Sanchez claims 6-11 as teaching a mixture of cyclodextrins, alpha, beta and gamma, from 1-30%.” Applicant’s attention is drawn to claim 11: “...wherein the cyclodextrins are selected from the group consisting of alpha-cyclodextrins, beta-cyclodextrins and gamma-cyclodextrins.” As can be seen by the plural “cyclodextrins” recited in claim 11, Sanchez does teach the combination/mixture of different cyclodextrins.

Applicant further argues that Sanchez teaches “empty” cyclodextrins whereas the newly added claims 16-23 herein claim the addition of cosmetic additives, e.g., oils, emollients, etc.

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Note that the addition of known cosmetic additives does not patentable distinguish the claimed invention over the cited prior art. One of ordinary skill in the art would be in possession of all known cosmetic additives herein, absent evidence to the contrary. No unexpected effect of the claimed cosmetic additives/excipients herein has been shown.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mojdeh Bahar whose telephone number is (703) 305-1007. The examiner can normally be reached on (703) 305-1007 on Monday, Tuesday, Thursday and Friday from 8:30 a.m. to 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Mojdeh Bahar
Patent Examiner
July 18, 2002

RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200